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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,683	11/24/2003	Francis Pruche	05725.1256-00	3211
22852	7590	04/13/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ROYDS, LESLIE A	
			ART UNIT	PAPER NUMBER
			1614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	04/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/718,683	PRUCHE ET AL.
	Examiner	Art Unit
	Leslie A. Royds	1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-69 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) 1-69 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

Claims 1-69 are presented for examination.

### *Requirement for Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-57, 66 and 68-69, drawn to a coloring composition for a keratin material comprising at least one coloring agent and at least one component chosen from a component (B) comprising at least one acidic composition and a component (C) comprising at least one alkaline composition, classified in class 424, subclass 63 or 70.6.
- II. Claims 58-65 and 67, drawn to a process for coloring a keratin material or a method for artificially tanning and/or browning the skin and/or giving a healthy complexion, classified in class 424, subclass 59.

The inventions are distinct, each from the other, for the following reasons:

Invention I and Invention II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the presently claimed composition of Invention I can be used in materially different processes of use, namely as a nail polish, for example.

Because these inventions are distinct for the reasons given above, they require a different field of search (see MPEP §808.02) and they have acquired a separate status in the art because of their recognized divergent subject matter, the requirement for examination purposes as indicated is proper.

### *Election of Species Requirement*

*Election of species should be made consistent with the following instructions:*

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Election of Group I or II requires the election of:

- (I) a single disclosed specie of dye precursor from those specifically claimed (see, e.g., claims 17-21) or a generic dye precursor not specifically claimed; and
- (II) a single disclosed specie of catalyst (1) from those specifically claimed (see, e.g., claims 1, 12-15) or a generic catalyst; and
- (III) a single disclosed specie of catalyst (2) from those specifically claimed (see, e.g., claims 1 or 16) or a generic catalyst; and
- (IV) a single disclosed specie of component (B) and/or (C) (see, e.g., claim 1).

Election of a single disclosed specie of component (B) and/or (C) must identify which component is elected (i.e., either (B); or (C); or (B) and (C)).

If Applicant elects component (B), a single disclosed specie of at least one acidic composition must be elected (see, e.g., claims 42 and 45-49), as well as a single disclosed specie of packaging for component (B) (see, e.g., claim 50).

If Applicant elects component (C), a single disclosed specie of at least one alkaline composition must be elected (see, e.g., claims 51 and 54-56), as well as a single disclosed specie of packaging for component (C) (see, e.g., claim 57).

If Applicant elects both component (B) and (C), an election must be made consistent with the instructions *supra* for each of components (B) and (C).

**Applicant is further required in reply to this action to elect embodiments of the invention in which (V) a solvent and/or packaging and/or form is present; or (VI) a solvent and/or packaging and/or form is NOT present. If Applicant elects embodiments wherein a solvent and/or packaging and/or form is present in the elected embodiment, then Applicant is required to further elect a**

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**single disclosed specie of solvent and/or packaging and/or form for examination on the merits consistent with the following instructions:**

If Applicant elects an embodiment wherein a solvent is present, election of a single disclosed specie of solvent for the at least one dye precursor (see, e.g., claims 26-28) or a generic solvent must be made.

If Applicant elects an embodiment wherein a specific packaging type is present, election of a single disclosed specie of packaging must identify whether a single composition packaged in a one compartment device is elected or whether two compositions packaged in a two compartment device is elected.

If Applicant elects a single composition packaged in a one compartment device, a single disclosed specie of device must be elected (see, e.g., claim 36).

If Applicant elects two compositions packaged in a two compartment device, a single disclosed specie of device must be elected for each of components (A1) and (A2) (see, e.g., claim 37-40).

If Applicant elects an embodiment wherein a specific form of the at least one coloring agent is present, election of a single disclosed specie of form for the at least one coloring agent (see, e.g., claims 34 and 41) or a generic form not specifically claimed must be made.

The species are independent and/or distinct for the following reasons:

Regarding the species of dye precursor, catalytic system, component chosen from (B) and/or (C), or solvent, the species are independent or distinct because the breadth of compounds and agents encompassed by these genera are structurally and chemically distinct from any one other compound or agent encompassed by the presently claimed genera such that a comprehensive search of the patent and non-patent literature for any one such compound or agent would not necessarily result in a comprehensive

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search of any one or more of the other compounds or agents recited in the claims. Additionally, in consideration of the number and significant chemical and structural variability of compounds or agents actually claimed by such genera, and the enormous number of combinations that arise out of the claimed genera of components, the disparate nature and breadth of compounds or agents encompassed by this genus precludes a quality examination on the merits, not only because a burdensome search would be required for the entire scope of the claim(s), but also because the consideration of the findings of such a search for compliance with the statutes and requirements set forth under 35 U.S.C. 101, 102, 103 and 112, would be unduly onerous. Further, though Applicant has recognized a common functionality to the claimed compounds, e.g., that they are capable of coloring a keratin material, it remains that the art does not necessarily recognize such a function as being shared by the entire claimed genera of compounds and, as a result, does not necessarily recognize their equivalency or interchangeability. Additionally, it also remains that the art may recognize an advantageous use for the compound in achieving the presently claimed objective that is not necessarily tied to its function as a keratin-coloring material.

Applicant is cautioned that the election of a particular specie of compound, agent, packaging or form, etc., wherein the elected specie(s) is/are not adequately disclosed or supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Currently, claims 1-69 are generic.

**Applicant is advised that a reply to this requirement must include explicit identification of the invention to be examined and each of the species that is elected consonant with this requirement and in accordance with the above instructions and a listing of all claims readable thereon, including any claims subsequently added.**

An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. Please reference MPEP §809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though this requirement be traversed (37 C.F.R. 1.143) and (ii) an identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The Examiner has required restriction between product and process claims. Where Applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim

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will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the Examiner withdraws the restriction requirement before the patent issues. See MPEP § 804.01.

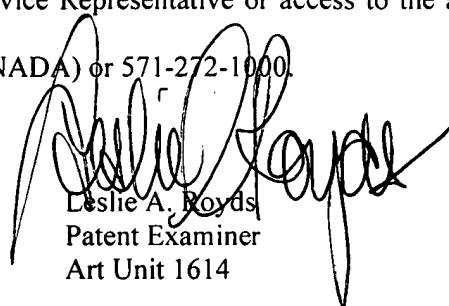
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leslie A. Boyd  
Patent Examiner  
Art Unit 1614

March 26, 2007



ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER